

REMARKS

Claims 37-58 are pending in the present application.

Applicants wish to thank Examiner Rodee for the helpful and courteous discussion with their undersigned Representative on October 7, 2004. During this discussion, several amendments and arguments were discussed to overcome the rejections over the art of record. Specifically, during the discussion, Applicants undersigned Representative and the Examiner discussed that fact that Merrill does not disclose or suggest the polyurethanes of the presently claimed invention (see Interview Summary dated October 7, 2004). The content of this discussion is reflected by the amendments and remarks set forth herein. Reconsideration of the outstanding rejections is requested in view of the amendments and remarks set forth herein.

The rejections of: (a) Claims 37, 39, and 40 under 35 U.S.C. §103(a) over Merrill (U.S. 3,703,372), and (b) Claims 38 and 52-58 under 35 U.S.C. §103(a) over Merrill (U.S. 3,703,372) in view of Diamond are obviated by amendment.

Merrill discloses an eletrochographic photoreceptor containing a photoconductor and binder, wherein the photoconductor comprises a certain class of polyesters having aryleneoxy repeating units (see Abstract). Diamond is cited as disclosing that formation of single layer photoconductors commonly include a charge transport compound in order to move the charge from the source of charge generation to the respective surface of the photoconductor, as well as additional “typical” components and processes present in electrophotographic apparatuses. Applicants note that at no point do either Merrill or Diamond disclose or suggest a

photoconductive layer which contains least one polyurethane resin that contains at least a structural unit represented by formula (1). Moreover, Applicants note that these references do not offer any suggestion to modify their disclosures to arrive at this limitation. Accordingly, Applicants submit that Merrill, even in combination with Diamond, fails to support a *prima facie* case of obviousness.

Applicants wish to acknowledge Examiner Rodee for the apparent recognition of the aforementioned deficiency in the art of record and the indication that “although the Examiner would have to update the search for claims limited only to the polyurethane, this appears to be a positive approach for further prosecution.” (Interview Summary dated October 7, 2004) As such, Applicants request acknowledgment that these grounds of rejection have been withdrawn.

The Examiner has rejected Claims 37-43 under the judicially created doctrine of obviousness-type double patenting over Claims 1-17 of U.S. 6,548,216.

Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c), disclaiming the terminal part of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. 6,548,216. Applicants note that the filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection.

Applicants respectfully request withdrawal of the rejection based on the judicially created doctrine of obviousness-type double patenting.

Finally, the Examiner required restriction in the present application as follows:

- Group I: Claims 37-43, and 52-58, drawn to a photoconductor having a specific polymer containing the formula (1) as a structural unit in the photoconductive layer and an apparatus containing the photoconductor;
- Group II: Claims 44-48, drawn to a photoconductor having a specific polymer in a protective layer of a photoconductive layer; and
- Group III: Claims 49-51, drawn to an imaging forming method;

Applicants affirm the election of Group I (Claims 37-43, and 52-58), with traverse.

In regard to Groups I-II and Group III, the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that the process as claimed can use a materially different product, such as a photoconductor having the polymer in the photoconductive layer, such as a charge generating layer. However, the Office has not provided reasons and/or examples to support this conclusion. Further, the Office has failed to show that the proposed method is materially different from the claimed use. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

In regard to Groups I and II, the Office has characterized the relationship between these two groups as subcombinations disclosed as usable together in a single combination. Citing MPEP §806.05(d), the Office concludes that the photoconductor of Group II has a separate utility such as in a process where the protective layer is removable from the photoconductive layer after formation of the toner image, and the toner image is transported with the surface layer to another receiver where the toner image is fixed. However, the Office has not provided reasons and/or examples to support this conclusion. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order

to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Further, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

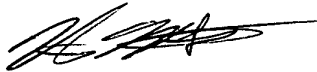
Applicants submit that a search of all claims would not constitute a serious burden on the Office.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

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